

REMARKS/ARGUMENTS

Reconsideration is respectfully requested of the Final Official Action of April 25, 2006, relating to the above-identified application.

Claim 15 has been amended to overcome the rejection under 35 U.S.C. § 112. It is submitted that Claim 15 complies with the provisions of the second paragraph of 35 U.S.C. § 112.

The rejection of Claims 1 to 17 under 35 U.S.C. § 112 (first paragraph) as failing to comply with the enablement requirement is traversed and reconsideration is respectfully requested. The Official Action alleges that the azo compound of Claim 1 encompasses an infinite number of compounds and places a burden on applicants to show "...that every possible permutation encompassed by the formula [of Claim 1] would function in the instant invention as an azo compound present in a gas black suspension", *see* Final Office Action, p 3, lines 1-2.

Whether making and using an invention would have required undue experimentation, and thus whether a disclosure is enabling under 35 U.S.C. § 112, Para. 1 (1994), is a legal conclusion based upon underlying factual inquiries. *Johns Hopkins Univ. v. Cellpro, Inc.* 152 F.3d 1342, 1354, 47 USPQ2d 1705, 1713 (Fed. Cir. 1998). Utility is a factual issue, which is reviewed for clear error. *See Cross v. Iizuka*, 753 F.2d 1040, 1044 n.7, 224 USPQ 739, 742 n. & (Fed. Cir. 1985); *see also In re Zurko*, 142 F.3d 1447, 1449, 46USPQ2d 1691, 1693 (Fed. Cir.), *cert. granted*, 119 S. Ct. 401 (1998).

Section 112, Para. 1 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise,

and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention

A lack of enablement rejection under section 112, Para. 1 is appropriate where the written description fails to teach those in the art to make and use the invention as broadly as it is claimed without undue experimentation. *See In re Vaeck*, 947 F.2d 488, 495-96, 10 USPQ2d 1438, 1444 (Fed. Cir. 1991).

This rejection takes several forms. The PTO may properly make a scope of enablement rejection where the written description enables something within the scope of the claims, but the claims are not limited to that scope. *See* Manual of Patent Examining Procedures ("M.P.E.P.") Section 706.03(c), form Para. 7.31.03 (Rev. 3, July 1997). This type of rejection is marked by language stating that the specification does not enable one of ordinary skill to use the invention commensurate with the scope of the claims. On the other hand, if the written description does not enable any subject matter within the scope of the claims, the PTO can make a general enablement rejection, stating that the specification does not teach how to make or use the invention. *See* M.P.E.P. Section 706.03(c), form Para. 7.31.02.

In the present case, the second type of rejection was made; see page 2 of the Final Action. The claims in the present case call for an aqueous, colloidal gas black suspension comprising the gas black, a defined azo compound and water.

In reply, applicants respectfully submit that the rejection is improper because the application contains actual working examples of the types of colloidal gas black suspensions encompassed by the invention. For example, the various substituents of the azo compounds are

disclosed and described beginning at the bottom of the page 3, at line 27, of the application. Further exemplification of azo compounds of the formula 1 are set forth on pages 4 and 5. Specific examples of compounds are shown on page 6. Working examples of the entire gas black suspension are found on pages 10 and 17. Ink formulations are found on page 21. It is true that the claim encompasses a large number of compounds, however, they are exemplified by representative compounds set forth in the application. Merely because the claim is broad, is not a reasonable basis for rejecting the claims as lacking enablement. The Official Action has not provided any reason why a person skilled in the art would not be able to make or use the suspensions encompassed by Claim 1.

If the written description fails to illuminate a credible utility, the PTO may properly make both a section 112, Para. 1 rejection for failure to teach how to use the invention and a section 101 rejection for lack of utility. *See* M.P.E.P. Section 706.03(a), form Para. 7.05.04. This dual rejection occurs because "[t]he how to use prong of section 112 incorporates as a matter of law the requirement of 35 U.S.C. Section 101 that the specification disclose as a matter of fact a practical utility for the invention." *In re Ziegler*, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (fed. Cir. 1993). Thus, an applicant's failure to disclose how to use an invention may support a rejection under either section 112, Para. 1 for lack of enablement as a result of "the specification's ...failure to disclose adequately to one ordinarily skilled in the art 'how to use' the invention without undue experimentation," or section 101 for lack of utility "when there is a claimed invention." *Environtech Corp. v. Al George, Inc.*, 730 F.2d 753, 762, 221 USP 473, 480 (Fed. Cir. 1984); *see also In re Brana*, 51 F.3d 1560, 1564 n.12, 34 USPQ2d 1436, 1439 n.12 (Fed. Cir. 1995) (The "absence of utility can be the basis of a rejection under both 35 U.S.C. §

101 and 112 Para. 1."); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) ("[I]f [certain] compositions are in fact useless, appellant's specification cannot have taught how to use them.").

The PTO cannot make this type of rejection, however, unless it has reason to doubt the objective truth of the statements contained in the written description. *See, Brana*, 51 F.3d at 1566, 35 USPQ2d at 1441 ("[T]he PTO has the initial burden of challenging a presumptively correct assertion of utility is the disclosure. Only after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the application to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility.") (citations omitted); *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971) "[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of Section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.").

In view thereof, it is believed that the rejection under 35 U.S.C. § 112 (first paragraph) is not well founded and withdrawal thereof is respectfully requested.

The rejection of Claims 1 to 17 in view of the claims of applicants' related application, App. No. 10/812,835, now U.S. Patent 7,005,004, is rendered moot by the submission herewith of a terminal disclaimer.

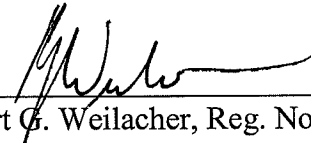
App. No. 10/534,860
Amend. dated July 25, 2006
Resp. to Final OA dated April 25, 2006

Favorable action at the earliest convenience of the Examiner is respectfully requested.

Respectfully submitted,

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